

### **REMARKS**

Prior to this amendment, claims 1-35 were pending, however, there were no claims that were numbered “33” and “34” when the application was filed. By this amendment, dependent claims 2, 21 and 35 have been canceled and new independent claims 36 and 37 have been added. Since the claim count prior to this amendment exceeded the claim count paid for by a basic filing fee, the Commissioner is hereby authorized to charge the deposit account of Scheef and Stone, L.L.P., deposit account number 502032, the fee required to add two new independent claims 36 and 37.

Referring now to the office action, claims 1 - 32 and 35 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over WO 00/08706 to Park et al., (Park) in view of U.S. patent number 6, 487,394 to Ue et al. (Ue).

Beginning on page 2, the Examiner reiterated the various limitations of independent apparatus claim 17 and ostensibly identified where various limitations of claim 17 can be found in the Park reference. On lines 8 and 9 of page 3, however, the Examiner admitted that Park does not satisfy the claim 17 limitation that requires evaluating a signal-to-noise ratio. The Examiner cited the Ue reference as teaching the evaluation of a signal to noise ratio, which the Examiner admitted is missing from Park.

The Examiner has not established *prima facie* obviousness because controlling Federal Circuit case law<sup>1</sup> and the MPEP<sup>2</sup> both require three separate criteria to be met in order to establish a *prima facie* case of obviousness. None of them are established in the office action.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's

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<sup>1</sup> See e.g., Dystar v. C.H. Patrick, (Fed. Cir., 2006), which is available on-line at <http://www.fedcir.gov/opinions/06-1088.pdf>.

<sup>2</sup> MPEP §706.02(j)

disclosure.” As stated above, none of these criteria are established by the Examiner in the office action. It therefore appears that the only motivation to combine Park and Ue is the applicant’s claims themselves.

Assuming, *arguendo*, that there is some teaching, suggestion or motivation to combine Park and Ue, claims 1 and 17 have been amended more carefully articulate the subject matter claimed by the applicant and to thereby traverse the obviousness rejection. Paraphrased, independent method claim 1 recites that the first signal sent from the base station to the mobile device is a “preamble” that is sent during the traffic channel initialization period in a CDMA network. Paraphrased, independent apparatus claim 17 has also been amended to recite that the first signal is a preamble sent during the traffic channel initialization period. By amending claims 1 and 17 in this way, both of them (and the claims that depend from them) clearly avoid Park and Ue.

Referring to the office action, the applicant acknowledges that Ue teaches evaluating a signal-to-noise ratio as the Examiner contends, however, Ue also teaches that the calculation of a signal-to-noise ratio should be performed repeatedly, i.e., not just during a channel initialization period. In Ue, transmission power levels and transmission data rates are repeatedly and continuously adjusted in response to signal degradation as detected by the repeated signal level tests.

Referring now to Ue, the Abstract states that “transmission rate” is switched or adjusted, when reception quality of the communication terminal apparatus deteriorates. In column 5, lines 10-15, Ue states that received signal conditions are reported “all the time.” In column 5, beginning at line 30, through column 6, line 48, Ue describes four methods for switching transmission rate in real-time based on reception quality. These methods make it clear that transmission quality is measured more frequently than during a traffic channel initialization period as the amended claims require. FIGS. 8 -11 also show that reception quality reports are exchanged between the “terminal apparatus” and the base station during message transfers. Ue clearly requires that reception quality, i.e., by the transmission of a “first signal” transmitted at a known power level, should be tested more than just during traffic channel initialization as

pending claims 1 and 17 now require. Ue therefore teaches away from what the applicant claims in the amended independent claims.

If the Examiner contends that there is some teaching or motivation to combine Park with Ue in order to satisfy the claim limitations that require a signal-to-noise ratio determination, the combination of Park and Ue, the combination of these two references therefore also requires that reception quality be repeatedly and continuously monitored and not just during a traffic channel initialization period as claims 1 and 7 now require. By amending claims 1 and 17 to require the “first signal” to be sent during an initialization period, the claimed signal to noise ratio is calculated only once for each initialization period. Claims 1 and 17 are therefore patentably distinguishable from Park and Ue, alone or in any combination.

As for the other claims, on pages 4-6, the Examiner purported to identify where the limitations of dependent apparatus claims 18-32 and 35 can be found in the Park reference. None of these limitations are actually disclosed in either reference. In order to reject claims 1 - 16, which are method claims, the Examiner simply cited bases for rejecting the corresponding apparatus claims.

Support for the amendments to claims 1 and 17 can be found in the specification on page 2 lines 9 - 13; page 3, lines 19 - 25 and page 6, lines 11 - 16. In each of these locations, the applicant's specification states that the mobile device calculates a signal-to-noise ratio based on the transmit power of a “preamble” broadcast from the base station. The title of the invention also recites that the method and apparatus being claimed is for power control, which occurs during “the traffic channel and naturalization period” of a CDMA network. No new matter has been added.

There is yet another reason why the Park and Ue combination does not render the claims obvious., In Park, the first paragraph on page 6 states in part that, “[A] base station transmits a reference pilot channel to the mobile station with a fixed power. Then, the mobile station measures the strength of [the] pilot signal and reports the measured value to the base station on an access channel. Based on the reported strength of the pilot signal, the base station determines the initial transmission power for a new traffic channel or control channel.” Park thus teaches that pilot signal strength is measured by the mobile station in order to allow the base station to

determine the transmission power for a new channel and not for the channel on which the test signal was broadcast. On this distinction as well, Park and Ue do not satisfy all of the limitations of claims 1 and 17.

As for the remaining claims, claim 7 has been amended to recite that the transmit power assigned to the forward like signal is assigned independently of the base stations transmission data rate. Ue is replete with references to changing transmit power as a function of data rate and vice versa. Claims 8 and 9 have been amended to make them depend from claim 1. Claims 2, 21 and 35 have been cancelled because their limitations have been subsumed into the corresponding independent claims.

New claim 36 is directed to a base station. Its limitations were derived from and are therefore supported by original claim 17 as well as FIGS. 1 and 2.

New claim 37 is directed to a mobile device. As with new claim 36, the limitations of claim 37 can be found in, and are supported by, original claim 17 as well as FIGS. 1 and 2. No new matter has been added by either claim 36 or 37.

The applicant submits that the foregoing argument and amendments traverse the rejections under 35 U.S.C. §103(a). The claims are in condition for allowance. Reconsideration of the claims is therefore respectfully requested.

Respectfully submitted,

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